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On page 4 of the Office Action, the Examiner asserts that, among other features, Uranaka suggests a medium having a read only area having original commodity catalog information, and a writeable area. On page 3 of the Office Action, the Examiner clarifies that Uranaka's description of a special purpose area containing media-utilizing information described a read only area other than a writeable area. Specifically, the Examiner asserts that the Examiner is interpreting the media-utilizing information as including original catalog content, such as the restaurant guide, etc. – content that does not need to change.

As a point of clarification, Uranaka teaches media utilizing information (such as that shown in FIGs. 1, 2, 4, 7, 11, 13, 16, and 21) that includes identification information regarding the title of the recording medium, information regarding addresses of the provider of the recording medium, information regarding the user, and/or an issue number for the recording medium. However, other than this identification information, Uranaka does not teach that the media utilizing information includes additional information regarding the specific items being provided on the recording medium, such as a restaurant guide or a information on items sold through a catalog recorded on the recording medium.

Specifically and with reference to FIGs. 12-16, Uranaka teaches a rewriteable DVD 1200 having a special purpose area 1201 containing media utilizing information 1300. The media utilizing information 1300 is recorded in advance in the special purpose area 1201, and is not updated by the user. The media utilizing information 1301 in the special purpose area 1201 includes title information 1301, issue number information 1302, a catalog shopping server network address 1304, and user information 1305. (Col. 17, lines 26-54; col. 18, lines 7-21; col. 20, lines 45-49; FIGs. 12-14 of Uranaka). However, Uranaka does not suggest that the media utilizing information 1301 also includes information on items originally provided with the DVD 1200 and which are to be sold using the DVD 1200. Since the special purpose area 1201 having the media-utilizing information 1300 is disclosed as being different from the original recording area of the DVD, Uranaka teaches that the information on the items being sold are in

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the remaining, rewritable area of the DVD 1200 on which the purchase histories and user certifications are also recorded. (Col. 17, lines 26-36, col. 19, lines 47-57, col. 20, lines 23-29; FIG 14 of Uranaka). Therefore, even assuming arguendo that the special purpose area 1201 of Uranaka is classifiable as a read-only area, there is no disclosure or suggestion that the information about the items being sold through the catalog on the DVD 1200 is included in the special purpose area 1201.

Alternately, there is no suggestion that updated media-utilizing information 1300 is received and recorded on the rewritable area of the DVD 1200. Specifically, Uranaka teaches that, when updated media-utilizing information 1300 is to be distributed, the distributor sends out a new DVD 1200 having the updated media-utilizing information 1300 already recorded in the special purpose area 1201. (Col. 20, lines 45-65 of Uranaka). Thus, Uranaka does not allow updated media-utilizing information 1300 to be recorded in the rewritable are of the DVD 1200 or in the special purpose area 1201.

In contrast, claim 1 recites "a read-only area in which original commodity catalog information is written," and "a writeable area in which updated commodity catalog information is written when provided by a server." Since Toyama et al. similarly does not suggest that the electronic publication medium has a read-only area, it is respectfully submitted that the combination of Uranaka and Toyama et al. does not disclose or suggest the invention recited in claim 1.

For similar reasons, it is respectfully submitted that the combination of Uranaka and Toyama et al. does not disclose or suggest the invention recited in claims 5, 16, 26, and 34.

On page 6 of the Office Action, the Examiner rejects claims 7, 8 and, 21 in view of the Examiner's statement that, since Uranaka suggests displaying items ranked higher in terms of user preference using past purchase history and displaying items which have already been ordered in the past versus items not yet ordered, it would have been obvious to incorporate one further display difference so as to encompass the display methods recited in claims 7, 8, and 21.

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However, as acknowledged by the Examiner, Uranaka does not specifically disclose or suggest such alternate display methods. Moreover, the Examiner asserts that col. 19, lines 26-33 of Uranaka teaches using past purchase history in the display. However, this portion of Uranaka discloses highlighting categories of commodities related to past purchases as compared to those not purchased such as through the use of a high ranking or by including images instead of merely text.

However, there is no suggestion that the displayed information about the commodity is highlighted or otherwise distinguished according to whether a portion of the information is updated as opposed to having been provided with the DVD 1200. There is further no suggestion that Uranaka teaches a display that compares updated versus not updated media utilizing information since Uranaka does not suggest recording updated media utilizing information. In contrast, claim 7 recites, among other features, that "the commodity catalog information is marked so that an updated portion and a non-updated portion are distinguished from each other," and claim 21 recites, among other features, "displaying both the existing and updated commodity catalog information such that the updated commodity catalog information is distinguishable from the existing commodity catalog information."

On page 3 of the Office Action, the Examiner clarifies that Uranaka teaches using different display methods such that Official Notice is not being taken. However, it is respectfully submitted that, even assuming arguendo that the Examiner is correct in that different display methods are disclosed, the different display methods are based upon purchase history as opposed to whether the particular commodity has been updated and recorded or was non-updated in the manner recited in claims 7 and 8, or whether the particular commodity was updated and recorded or existing as recited in claim 21. Since Uranaka does not disclose distinguishing displayed commodities in this manner as opposed to according to past purchase history, and since Tovama et al. does not suggest such alternate display methods, it is

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respectfully submitted that the combination of Uranaka and Toyama et al. does not disclose or suggest the invention recited in claims 7, 8, and 21.

Lastly, on pages 10-11 of the Office Action, the Examiner asserts that Uranaka discloses a writable area including a write once area and a rewritable area as recited in claim 42 for the same reasons as to why the Examiner believes Uranaka discloses the features of claims 1, 5, 16, 26, and 34. By way of review, claim 42 recites, among other features, "a read-only area in which original commodity catalog information is written" and "a writeable area in which updated commodity catalog information is written when provided by a server," wherein "said writeable area comprises a write once area to which data can be written once; and a rewriteable area to which data can be repeatedly written and/or from which data can be erased."

In contrast, even assuming arguendo that Uranaka discloses that the media-utilizing information 1300 having the special purpose area 1201 is not again written by the user, there is no suggestion that the remaining area of the rewritable DVD 1200 contains a write once area and a rewriteable area as recited in claim 42. Instead, Uranaka teaches that the remainder of the DVD 1200 is rewritable. Since Toyama et al. is not relied upon as curing this deficiency, it is respectfully submitted that the combination of Uranaka and Toyama et al. does not disclose or suggest the invention recited in claim 42.

Claims 2-4, 6, 9-15, 18-20, 22-25, 27-33, and 35-41 are deemed patentable due at least to their depending from corresponding claims 1, 5, 16, 26, and 34.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

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If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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on 16 March 2003

STAAS & HALSEY

By: 
Date: 16 March 03